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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,223	01/16/2002	Martin Schautt	DT-6057	6390

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/050,223

Applicant(s)

SCHAUTT, MARTIN

Examiner

Jennifer H Gay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Based on these papers, the rejections based on the Hauptmann et al. (US 2001/0013430) have been withdrawn.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Musacchia (US 5,273,380).

*Regarding claims 7 and 8:* Musacchia discloses a drill bit that includes the following features:

- A main bit formed by two diametrically offset cutting edges (24 and 26).
- Auxiliary bit (58) located in a radially outer region of the drill head (see Figures 8 and 11). The auxiliary bit includes an arcuate cutting edge (38) that is circumferentially axially rounded.

*Regarding claim 9:* The two cutting edges of the main bit are connected at the tip of the drill bit by an edge (see Figures 8 and 11).

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Musacchia (US 5,273,380) in view of Neukirchen et al. (US 5,492,187, previously cited).

Musacchia discloses all of the limitations of the above claims except for the auxiliary bit being axially offset with respect to a generation curve of the main bit. In column 4, lines 33-38, Neukirchen et al. teaches a drill head with a main bit and two auxiliary bits that are axially offset with respect to a generation curve of the main bit (see Figure 3). It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the auxiliary bit of Musacchia so that it was axially offset with respect to a generation curve of the main bit as taught by Neukirchen et al. in order to have provided cutting edges spaced from the cutting edges of the main bit thus providing more efficient cutting and cleaning of the borehole.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Musacchia (US 5,273,380).

Musacchia discloses a drill bit that includes the following features:

- A main bit formed by two diametrically offset cutting edges (24 and 26).
- Auxiliary bits (58) located in a radially outer region of the drill head (see Figures 8 and 11). The auxiliary bit includes an arcuate cutting edge (38) that is circumferentially axially rounded.

Musacchia discloses all of the limitations of the above claims except for the auxiliary bits forming a pointed wedge angle of between 50° and 80°. However, it would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the auxiliary bits of Musacchia with a pointed wedge angle between 50° and 80°, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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***Response to Arguments***

7. In view of applicant's amendment, the objections to the drawings and specification have been withdrawn.

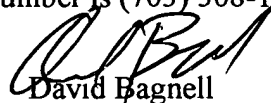
8. Applicant's arguments with respect to claims 7-11 have been considered but are moot in view of the new ground(s) of rejection.


***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
David Bagnell  
Supervisory Patent Examiner  
Art Unit 3672

JHG   
June 12, 2003